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Christopher Cianciolo  
Nortel Networks  
Intellectual Property Law Group  
600 Technology Park Drive  
Mail Stop E65-60-104  
Billerica, MA 01821-5501

Re: Patent Application Serial No.: 10/603065  
Your Ref: 13448 CK  
Our Ref: 120-380

Dear Chris:

With regard to the above-identified patent application, enclosed is:

- ☒ Office Action received, please instruct; RR
- ☐ Final Office Action received, please instruct;
- ☐ Amendment filed;
- ☐ Notice of Allowance, Issue Fees due \_\_\_\_\_;
- ☐ Issue Fee paid;
- ☐ RCE filed;
- ☐ Updated/Corrected/Filing Receipt;
- ☐ Notice of Appeal/Appeal Brief;
- ☐ Issue Notification;
- ☐ Correspondence from Foreign Associate with enclosures;
- ☐ Publication Notice.
- ☐ Assignment Recorded on \_\_\_\_\_ Reel/Frame \_\_\_\_\_
- ☐ Other: \_\_\_\_\_

If you have any questions or comments, please do not hesitate to contact us.

Very truly yours,

Steubing McGuinness & Manaras LLP

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David A. Dagg  
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## UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,065	06/24/2003	Peidong Wang	CORE-67 CON	8630
7990 12/16/2004				
Pandiscio & Pandiscio 470 Totten Pond Road Waltham, MA 02451-1914		EXAMINER FLORES RUIZ, DELMA R		
		ART UNIT PAPER NUMBER 2828		

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RR  
due 1/16/05

120-380

13448 CK

**Office Action Summary**

Application No.

10/603,065

Applicant(s)

WANG ET AL.

Examiner

Delma R. Flores Ruiz

Art Unit

2828

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-43 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Application/Control Number: 10/603,065  
Art Unit: 2828

Page 2

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 - 10, and 23 - 32 drawn to a tunable Fabry-Perot filter, classified in class 372, subclass 20.
- II. Claims 11 - 22 and 33 - 43, drawn to a method for making a tunable Fabry-Perot filter, classified in class 438, subclass 29.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case. That the product as claimed can be made by another and/or materially different process, the process of making is considered a different scope of the invention of the product made since the product made can be manufacture in different manners and the scope is directed to the structural relationship between the components of the apparatus and their functions. However, the process of

Application/Control Number: 10/603,065  
Art Unit: 2828

Page 3

making is the direct process of how each piece is manufacture and joint together to form the structure itself.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper..

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Application/Control Number: 10/603,065  
Art Unit: 2828

Page 4

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delma R. Flores Ruiz whose telephone number is (571) 272-1940. The examiner can normally be reached on M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Min Sun Harvey can be reached on (571) -272-1835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Delma R. Flores Ruiz  
Examiner  
Art Unit 2828

  
Min Sun Harvey  
Supervisor Patent Examiner  
Art Unit 2828

DRFR/MH  
December 10, 2004